

REMARKS

Claims 1 and 8-15 have been amended. Claims 1-6 and 8-15 are pending in this application. Applicant reserves the right to pursue the original and other claims in this and other applications.

Claims 1 and 9 are objected to for informalities. Applicant submits that claims 1 and 9 have been amended to recite “automatically converts the property into an assertion description if the property is to be verified during assertion verification.” Applicant respectfully submits that the objection be withdrawn and the claims allowed.

Claims 1-15 are rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. This rejection is respectfully traversed and reconsideration is respectfully requested in light of the above amendments and the following remarks.

Applicant respectfully submits that Applicant’s invention as claimed meets the requirements set forth in § 101. The text of the statute is provided below:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 101. With respect to a claimed process, the Supreme Court has held that “[a] claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385, 1391 (Fed. Cir. 2008) (en banc). Moreover, patent eligibility is determined based on the claim as a whole and not whether selected limitations constitute patent-eligible subject matter. *Id.* at 1394.

Applicant’s invention relates to a technology that automatically generates an assertion description of a property which verifies the specification of a semiconductor integrated circuit. According to the Federal Circuit, a method is patent-eligible under § 101 if it is “tied to a particular

machine or apparatus,” not counting any activity that is “insignificant” or “extra-solution.” *In re Bilski*, at 1391, 1393, n.14. Claim 1 recites an assertion generating system comprising “a computer readable storage device having a first storing unit that stores the design data generated by the specification inputting unit.” Thus, the generation of an assertion description by the assertion generating system of claim 1 is indeed “tied to a particular machine or apparatus.” Moreover, storage of the design data by the computer readable storage device is a critical part of what is claimed as the stored design data is the input into the property generating unit that generates a property which verifies the specification based on the design data. As such, the assertion generating system of claim 1 is tied to at least one particular machine or apparatus in ways that are not insignificant and that are not extra-solution in nature. Therefore, claim 1 passes the first prong of the machine-or-transformation test.

Claim 8, as amended, recites limitations that are similar to those discussed above in connection with claim 1. Therefore, the § 101 rejection of claims 1 and 8 should be withdrawn.

Claim 9, as amended, is in the form approved in M.P.E.P. § 2106.01(I) (“a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory”). Thus, the § 101 rejection of claim 9 should be withdrawn.

Claim 15 recites a method of making a semiconductor device using an assertion description, the method comprising “a manufacturing step that manufactures a semiconductor device based on specifications of the integrated circuit.” The manufacturing step of claim 15 necessarily passes the second prong of the machine-or-transformation test because the claimed process “transforms a particular article into a different state or thing,” namely, a semiconductor device. Therefore, the § 101 rejection of claim 15 should be withdrawn.

Claims 2-6 depend from claim 1 and claims 10-14 depend from claim 9. Accordingly, Applicant respectfully submits that claims 1-6 and 8-15 are in compliance with 35 U.S.C. § 101. Thus, Applicant requests that the rejection be withdrawn and the claims allowed. In view of the above, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By 
Mark J. Thronson

Registration No.: 33,082

Cathy Chen

Registration No.: 61,337

DICKSTEIN SHAPIRO LLP

1825 Eye Street, NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicant